

Application No. 10/698,070

Reply to Office Action

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REMARKS/ARGUMENTS*The Pending Claims*

Claims 1, 3-26, 35-43, and 45-54 are pending, which claims are directed to a composition for the inhibition of translation of a Mect1-MAML2 chimeric gene (claims 1, 3-26, 35-43, 45, and 46) and a method of using the composition (claims 47-54). Claims 7 and 17 currently are withdrawn. Claims 47-54 are new and directed to non-elected subject matter, which was previously withdrawn by the Office

Amendments to the Claims

Claim 1 has been amended to recite "a nucleic acid complementary to the fragment, optionally comprising *1 to 3 substitutions*" as supported by the specification at, for example, page 6, lines 18-20. Claims 15 and 37 have similarly been amended to recite "1 to 3 substitutions" as supported by the specification at, for example, page 6, lines 18-20. Claim 2 has been canceled. Claims 47-54 are new and are directed to subject matter set forth in original claims 27-34 (now canceled). No new matter has been added by way of these amendments.

Summary of the Office Action

The Office Action indicates that claims 40-43, 45, and 46 are in condition for allowance. The Office Action rejects claims 1-6, 8-16, 18-26, and 35-39 under 35 U.S.C. § 112, first paragraph, for allegedly lacking enablement. Reconsideration of this rejection is hereby requested.

Discussion of the Enablement Rejection

The Office contends that the specification lacks enablement for compositions comprising a fragment of a nucleic acid encoding SEQ ID NO: 12 and a nucleic acid complementary to the fragment having *up to 10 base substitutions*. The Office acknowledges that the specification is enabling for a composition comprising a fragment of a nucleic acid encoding SEQ ID NO: 12 and a nucleic acid complementary to the fragment having up to 3 substitutions.

Application No. 10/698,070

Reply to Office Action

The claims have been amended to recite that the nucleic acid complementary to the fragment optionally comprises 1 to 3 substitutions. In view of the amended claims, the enablement rejection is moot. Accordingly, Applicants respectfully request that the enablement rejection is withdrawn.

Discussion of Withdrawn Claims 7 and 17

The Office previously acknowledged that claim 1 links the subject matter of withdrawn claims 7 and 17, and is, thus, a "linking claim" (see pages 3-4 of the Office Action dated August 24, 2005). As set forth in MPEP § 809, when all claims directed to the elected invention are allowable, should any linking claim be allowable, the restriction requirement between the linked inventions must be withdrawn. Any claims directed to the non-elected inventions, previously withdrawn from consideration, which depend from or require all the limitations of the allowable linking claim must be rejoined and be fully examined for patentability.

Applicants therefore request, upon a finding that claim 1 is in condition for allowance, that the restriction requirement as to claims 7 and 17 be withdrawn.

Rejoinder of Claims Directed to the Process of Using the Claimed Product

As set forth in the Office Action dated May 2, 2005 (see pages 3-4) and in accordance with MPEP § 806.05(f), when the Office requires restriction between product and process claims and Applicants elect claims directed to the product, which claims are subsequently found to be allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claims will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all of the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR § 1.104.

Non-elected claims 27-34 (now claims 47-54) are directed to a method of using the composition of claim 1. Thus, claims 27-34 (now claims 47-54), by virtue of their

Application No. 10/698,070

Reply to Office Action

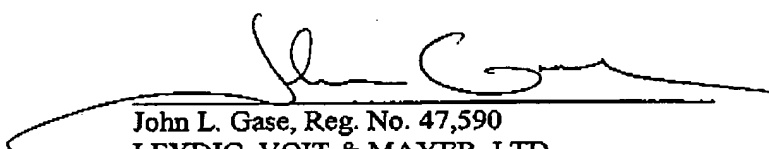
dependency from claim 1, include all of the limitations of claim 1. Such claims must be rejoined and examined together with the product claims.

Applicants therefore request, upon a finding that claim 1 is in condition for allowance, that the restriction requirement as to the process claims (i.e., the claims of Group II) be withdrawn.

Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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